

REMARKS

Claims 77-86 and 109-148 are pending in the current application. Applicants have amended independent claims 77, 109, 119, 128, and 137. No new matter has been added. Reexamination and reconsideration of all claims, as amended, is respectfully requested.

Applicants particularly thank the Examiner for the guidance at p. 6 of the Office Action regarding suggested subject matter. As discussed below, Applicants have taken this suggested subject matter and incorporated the suggestions into the pending independent claims.

The Office Action initially asserts that “the amendments to claims 77, 109, and 119 were already present in the previously filed response on 08/27/2007...” Office Action, p. 2. This is not strictly correct – for example, the Amendment Accompanying Request for Continued Examination, filed October 22, 2008, includes the underlined word “deform” in claims 77 and 109, indicating the words were added. Applicants particularly note that the present Office Action does not address the amended “deform” aspect of these claims. In any event, Applicants make certain amendments herein at least partially based on the Examiner’s suggested subject matter, and request full consideration of the claims, as amended.

§ 103

The Office Action rejected claims 77, 80-86, 109, 112-116, 119, 122-125, 128, 130-134, 137-139, and 141-146, including independent claims 77, 109, 119, 128, and 137 under 35 U.S.C. § 103 based on Bylsma, U.S. Patent No. 6,319,220 (“Bylsma”) in view of Dotson, Jr., U.S. Patent No. 4,274,411 (“Dotson”). The Office Action rejected claims 78-79, 85-86, 110-111, 117-118, 120-121, 126-127, 129-131, 135-136, 140-141, and 147-148 based on Dotson in view of Bylsma, referencing Gonan, U.S. Patent 6,423,028 (“Gonan”) for certain claimed ranges/values.

Applicants have reviewed the Examiner's suggested subject matter and have amended the independent claims of the present application to recite certain structure, namely tubing deformation structure ("applying a series of modulated differential pressure pulses to the ocular region via a tubing deformation fluid control device configured to selectively deform and substantially close aspiration tubing to selectively provide aspirating fluid from the ocular region", claim 77, with similar amendments to all other independent claims).

Applicants submit that these amendments distinguish the claims from the disclosure of Bylsma and/or Dotson, and provide the recitation of structural elements that define the aspiration components as suggested by the Office Action.

With respect to Bylsma, the Bylsma reference teaches a design providing a relatively constant flow, not a periodic flow, and fails to disclose or suggest a tubing deformation fluid control device as claimed. Bylsma discusses randomly controlling fluid flow, not selectively controlling or deforming, and does not teach or suggest "applying a series of modulated differential pressure pulses to the ocular region via a tubing deformation fluid control device configured to selectively deform and substantially close aspiration tubing to selectively provide aspirating fluid aspirating fluid from the ocular region..."

Dotson fails to make up for the deficiencies of Bylsma. Dotson shows a device employing a series of valves that do not deform tubing nor constitute a "tubing deformation fluid control device" as claimed. Dotson does not teach or suggest deformation of aspiration tubing as claimed, but instead keeps all illustrated tubing intact and undeformed. *See, e.g.* Dotson, col. 3, lines 30-39 and lines 48-50 and col. 5, lines 18-29. Dotson therefore does not teach or suggest "applying a series of modulated differential pressure pulses to the ocular region via a tubing deformation fluid control device configured to selectively deform and substantially close aspiration tubing to selectively provide aspirating fluid to periodically provide aspirating fluid from the ocular region..." as claimed.

Combination of References

Applicants disagree that one of ordinary skill in the art would have a reason to combine the features disclosed in the Bylsma and Dotson references in the manner suggested in the Office Action. Dotson is solely relied on as purportedly showing inhibiting fluid flow and fails to teach or suggest deformation of tubing in the manner claimed. Bylsma is relied on for its peristaltic pump, which operates in a different manner than claimed, and the ultrasonic limitations of the present claims. Applicants submit that a combination of Bylsma and Dotson is unreasonable, and such a combination uses hindsight to reconstruct the claimed invention. As noted, neither Dotson nor Bylsma apply a series of modulated differential pressure pulses to the ocular region via a tubing deformation fluid control device configured to selectively deform and substantially close aspiration tubing to selectively provide aspirating fluid from the ocular region. Bylsma does not discuss modulated differential pressure pulses, much less selectively deform and substantially close aspiration tubing, and thus would not be relied on to solve the problem currently solved by the present design, namely providing selective fluid flow into the region, in certain instances in addition to delivering ultrasonic energy.

The PTO has the burden of establishing a *prima facie* case of obviousness under 35 USC §103. The Patent Office must show that there is some reason to combine the elements with some rational underpinning that would lead an individual of ordinary skill in the art to combine the relevant teachings of the references. *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Therefore, a combination of relevant teachings alone is insufficient grounds to establish obviousness, absent some reason for one of ordinary skill in the art to do so. *Fine* at 1075. In this case, the Examiner has not pointed to any cogent, supportable reason that would lead an artisan of ordinary skill in the art to come up with the claimed invention.

None of the references, alone or in combination, teach the unique features called for in the claims. It is impermissible hindsight reasoning to pick a feature here and there from among the references to construct a hypothetical combination which obviates the claims.

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. *[citation omitted]*

In re Gordon, 18 USPQ.2d 1885, 1888 (Fed. Cir. 1991).

The Federal Circuit has stressed that the “decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made.” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). To do otherwise would be to apply hindsight reconstruction, which has been strongly discouraged by the Federal Circuit. *Id.* at 1568.

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner’s conclusory statements in support of the alleged combination fail to establish a *prima facie* case for obviousness. See, *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007) (obviousness determination requires looking at “whether there was an apparent reason to combine the known elements in the fashion claimed...,” *citing In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere

conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” KSR at 14).

The reasoning supporting the combination is “to provide a system that aids in the aspiration of hard to remove pieces of material...” Office Action, p. 4. This is merely a conclusion used to justify choosing references based on aspects presented in the claims. It is always beneficial to improve operation, cost, efficiency, and so forth, but the question is what reasoning would have been used by one of skill to take the ultrasonic teachings of the Bylsma ultrasonic device and peristaltic pump and modify them in a manner consistent with the Dotson fluid design. Here, no such reason has been articulated. Conclusory reasoning such as that presented is improper hindsight reconstruction of the invention and for this further reason, claims 77, 109, 119, 128, and 137, as amended, and claims depending therefrom are allowable over the cited references.

Based upon the totality of the foregoing, Applicants respectfully submit that claims 77, 109, 119, 128, and 137, as amended, are allowable over the references of record, and all claims dependent therefrom are also allowable as they include limitations not present in the cited references.

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 103.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims, as amended, are respectfully requested and allowance of all the claims at an early date is solicited.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicants believe that no fees are due in accordance with this Response. Should any fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account 502026.

Respectfully submitted,



Steven W. Smyrski, Esq.
Registration No. 38,312

Date: April 14, 2009

SMYRSKI LAW GROUP, A.P.C.
3310 Airport Avenue, SW
Santa Monica, California 90405-6118
Phone: 310.397.9118
Fax: 310.397.9158
AMO0007 Resp to Office Action 04_14_09